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Paper No. 5

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**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of
David R. Smith et al.
Application No. 09/729,562
Filed: December 4, 2000
Attorney Docket No. 500582.20016

ON PETITION

This is in response to the "Petition Under 37 CFR 1.47(a)," filed June 29, 2001.

The petition is dismissed.

Rule 47 petitioner is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), petitioner must demonstrate with documented evidence that an inventor refuses to join in the application after having been presented with the application papers (specification, claims and drawings). There is no indication in the present case whether joint inventor Duane Eareckson was presented with a copy of the complete application papers. If joint inventor Mr. Eareckson was not presented with a copy of the application papers, then Mr. Eareckson could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. See

MPEP 409.03(d). Unless petitioner can show that a copy of the application papers was presented to Mr. Eareckson, then petitioner will have to mail a copy of the complete application papers to Mr. Eareckson at his last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc., to support a showing that Mr. Eareckson has refused to sign the declaration after having been presented with the application papers. See MPEP 409.03(d).

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Wan Laymon.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed
to Wan Laymon at (703) 306-5685.



Frances Hicks
Lead Petitions Examiner
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for Patent Examination Policy